

REMARKS

This amendment is submitted in response to the non-final Office Action mailed May 4, 2006. Following entry of this amendment, claims 1-3, 5-27, 29-46 and 48-65 remain pending in this application. In the Office Action, the Examiner:

- rejected pending claims 1-8, 11-12, 21, 25-33, 44-51, 53, 60 and 64-65 under 35 U.S.C. § 103(a) as obvious in view of United States Patent No. 4,408,601 to Wenk (hereinafter “Wenk”) in combination with United States Patent No. 5,709,686 to Talos et al. (hereinafter “Talos”);
- rejected pending claims 10, 13-20, 22, 24, 34-39, 41, 43, 52, 54-59, 61 and 63 under 35 U.S.C. § 103(a) as obvious in view of Wenk in combination with both Talos and U.S. Patent No. 3,716,050 to Johnston (hereinafter “Johnston”); and
- rejected pending claims 23, 42 and 62 under 35 U.S.C. § 103(a) as obvious in view of Wenk in combination with both Talos and U.S. Patent No. 6,623,486 to Weaver et al. (hereinafter “Weaver”).

In response, applicant has amended claims 1, 25, and 44 to include the limitations of canceled claims 4, 28 and 47, respectively. Claim 23 has also been amended to appear in independent form. No new matter has been added. These claim amendments do not represent acquiescence in the Examiner’s rejections, but rather are made only to expedite prosecution of the present application. Applicant expressly reserves the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicant respectfully submits that each of the currently pending claims define features of the present invention that are not disclosed, taught or suggested by the prior art of record and respectfully requests allowance of same.

**Claim Rejections - 35 U.S.C. § 103(a)**

**(a) Wenk In Combination With Talos**

Claims 1-8, 11-12, 21, 25-33, 44-51 53, 60 and 64-65 were rejected under 35 U.S.C. § 103(a) as obvious in view of Wenk in combination with Talos. Applicant respectfully traverses these claim rejections and, for the reasons discussed below, submits

that amended independent claims 1, 25 and 44, and previously presented independent claim 64, are not obvious in view of the cited combination. More particularly, applicants note that the cited references do not disclose, teach or suggest a bone plate comprising, *inter alia*, at least one combination hole including a first portion having a substantially circular outer periphery defining a first center point, and a plurality of threads disposed on the outer periphery; and a second portion overlapping the first portion and having an elongated outer periphery defining a second center point; wherein the first center point is spaced apart from the second center point along the upper surface, and the plurality of threads extend over an angle of greater than about 180° with respect to the first center point, as recited in amended claim 1. Claims 25 and 44 have been similarly amended, and claim 64, as originally presented, includes a similar limitation.

The Office Action clearly states that Wenk fails to disclose certain elements, including “the plurality of threads disposed on the outer periphery of the first portion of the combination hole extending over an angle greater than about 180°”, but the Examiner cites FIG. 1 of Talos as showing “a plurality of threads disposed on the outer periphery of the first portion of the combination hole extending over an angle greater than about 180° . . .” (May 4, 2006 Office Action at 3 (hereinafter “Office Action”).) However, with regard to FIG. 1, Talos explicitly states that the partial thread does *not* extend over an angle greater than 180° — “[a]n inside thread is in the circular segment of the hole 2 and, because of design constraints, runs only in the lateral part of the plate over an angular range of about 60° to 179°, preferably about 90° to 150°.” (Talos at col. 2, lines 40-44.) Therefore, applicants respectfully submit that Talos clearly does *not* disclose a combination hole where the plurality of threads extend over an angle of greater than about 180° with respect to the first center point, as recited in amended claims 1, 25 and 44 and previously presented claim 64.<sup>1</sup>

Accordingly, for at least this reason, applicant respectfully requests that the obviousness rejection of claims 1, 25, 44 and 64 be withdrawn and that those claims, and each of their dependent claims 2-3, 5-22, 26-27, 29-43, 45-46, and 48-63, be allowed.

(b) Wenk In Combination With Both Talos And Weaver

Applicant notes that claims 23, 42 and 62 have been rejected under 35 U.S.C.

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<sup>1</sup> Applicants also pointed out that Talos does not disclose this claimed feature in response to the previous Office Action.

§ 103(a) as obvious in view of Wenk in combination with both Talos and Weaver. More particularly, the Office Action states that Wenk and Talos fail to disclose “the bone screw having a threaded head for engaging the first portion of the combination hole,” and the Examiner cites Weaver as showing a bone screw with threaded head. (Office Action at 5.) As discussed above, while each of these claims is allowable because the claims from which they depend, i.e., currently pending claims 1, 25 and 44, respectively, are not obvious in view of the combination of Wenk with Talos, applicant also respectfully submits that this rejection should be withdrawn because, pursuant to 35 U.S.C. § 103(c), Weaver is disqualified as prior art used in an obviousness rejection.<sup>2</sup> In support of this statement, and pursuant to MPEP 706.02(l)(2)(II) applicant, by and through its attorneys, respectfully submits that:

Weaver and the present application were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, Synthes (U.S.A.).

Applicant further submits that the assignment records demonstrating that the parent to the present application (now U.S. Patent No. 6,669,701) and Weaver are commonly owned by Synthes (U.S.A.) have been recorded with the Patent Office at Reel 013792, Frame 0809, and Reel 011364, Frame 0057, respectively. Consequently, Applicant respectfully submits that the obviousness rejection of claim 23, which has been rewritten in independent form, and claims 42 and 62 should be withdrawn because Weaver is not available as prior art in this context.<sup>3</sup>

(c) Claim 65

Claim 65, which was rejected based on the combination of Wenk with Talos, recites, *inter alia*, a bone fixation system including a bone plate with a combination hole and a bone screw having a threaded head. Since, as discussed above, the Office Action states that Wenk and Talos fail to disclose “the bone screw having a threaded head for engaging the first portion of the combination hole” (Office Action at 5), applicants respectfully request withdrawal of the obviousness rejection of claim 65 based on Wenk with Talos. Moreover, applicants respectfully submit that claim 65 is allowable over the prior art of record.

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<sup>2</sup> Weaver only qualifies as prior art to the present application under 35 U.S.C. § 102(e) because Weaver was first published on Sept. 23, 2003, after the Jan. 27, 2000 priority date of the present application.

<sup>3</sup> Applicants also made this point in responding to the previous Office Action, which also applied Weaver in rejecting claims 23, 42 and 62 on grounds of obviousness.

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In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider pending claims 1-3, 5-27, 29-46 and 48-65 with a view towards allowance. The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

A separate petition for a one-month extension of time is submitted herewith. Should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

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